

AMENDMENT AFTER NON-FINAL ACTION

Appln. No. 10/686,353

Docket No. 066491-00007

**REMARKS**

Claims 1-3, 8-9, 11, 17-27, 32-35, and 37-41 are pending in the application. Claims 1-3, 8-9, 11, 17-27, 32-35, and 37-41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication 2002/0092203 to Hardt ("the Hardt '203 publication") in view of U.S. Patent No. 7,020,988 to Holden et al. ("Holden '988"). Claims 1-3, 8-9, 11, 17-27, 32-35, and 37-41 also stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Hardt '203 publication in view of U.S. Patent No. 5,218,056 to Santianont et al. ("Santianont '056").

*Rejection of all claims under § 103(a) over the Hardt '203 publication in view of Holden '988*

Claims 1-3, 8-9, 11, 17-27, 32-35, and 37-41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Hardt '203 publication in view of Holden '988. Holden '988 has a prior art date under 35 U.S.C. § 102(e) of August 29, 2003 and does not claim the same patentable invention as the present application. *See* Holden '988 cover page and claims 1, 10, and 15; Application claims 1 and 27.

The Applicants respectfully submit a declaration under 37 C.F.R. § 1.131 to antedate Holden '988. MPEP § 715. The Applicants conceived of the claimed invention and reduced the claimed invention to practice prior to August 29, 2003. The Applicants also conceived of the claimed invention and acted with due diligence from prior to August 29, 2003 to the filing of the present Application on October 14, 2003. Therefore the Applicants respectfully argue that the rejections based upon Holden '988 have been overcome.

*Rejection of all claims under § 103(a) over the Hardt '203 publication in view of Santianont '056*

Claims 1-3, 8-9, 11, 17-27, 32-35, and 37-41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Hardt '203 publication in view of Santianont '056. The Office alleges that "Santianont discloses a midsole/insole with first and second pad where the rebound

AMENDMENT AFTER NON-FINAL ACTION

Appln. No. 10/686,353

Docket No. 066491-00007

of the first pad differing from the rebound rate of the second pad to provide a variable yet large range of cushioning effects, which is necessary for use in different sports activity (see column 4, lines 63-68 and column 5, lines 1-4 and table 3)." Office Action mailed 3/12/2007 at p. 4. The Office further argues that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the rebound of the first pad different from the rebound of the second pad as taught by Santianont to provide a variable yet large range of cushioning effects, which is necessary for use in different sports activity." *Id.*

*Santianont '056 does not disclose an insole combining multiple elastomeric pads having different hardness and rebound properties*

The Applicants respectfully dispute the Office's interpretation of Santianont '056, and suggest that although the cited portions of the reference disclose multiple elastomer materials having different rebound properties, the reference does not disclose or suggest an insole combining multiple elastomeric pads having different hardness and rebound properties, but only an insole including multiple elastomeric pads having the same properties, the properties being varied identically among different insoles to provide cushioning effects suitable for a particular body weight or a particular sporting activity. Santianont states that:

An insole/midsole component [in footwear] can be constructed from such an elastomer to have a required hardness, compression set and a required percentage rebound resilience at constant thickness by varying the degree of cross-linking. In consequence, different insole/midsole components [for footwear] can provide a *variable yet large range of cushioning effects*, which is necessary for potential users of the footwear having *different body weight ranges*, and also for use in *different sports activities*.

Santianont '056 at col. 1 ll. 36-44 (bracketed material not explicitly in original) (emphasis added). *See id.* at abstract ("It is therefore highly suitable for insole and/or midsole components

AMENDMENT AFTER NON-FINAL ACTION

Appln. No. 10/686,353

Docket No. 066491-00007

in footwear."). Without reference to the Applicants' specification "different insole/midsole components" would be read as describing different insoles/midsoles for footwear having pairs of pads constructed from the same material, e.g., that of Specimen A or Specimen B or specimen C, and not as describing or suggesting a single insole/midsole having different pad components constructed from different materials, e.g., one of Specimen A or B and one of Specimen C, as alleged by the Office. Corroborating evidence supporting this 'same material' interpretation is set forth below.

Santiyanont characterizes a prior art reference, U.S. Patent No. 4,451,994, as disclosing "a sponge rubber insole component with air spaces," referring in a like manner to an entire insole/midsole for use in a piece of footwear. *See* U.S. Patent No. 4,451,922, abstract and col. 3 ll. 41-64. Santiyanont distinguishes the patented invention from such prior art by noting that "it has also been found that any one of the [prior art] insoles is only useful for a very limited range of body weight of potential users for the footwear," Santiyanont '056 at col. 1 ll. 62-65, and claiming that "[an] advantage of the invention is that a range of insole/midsole components [for footwear] can be provided having shock-absorbing and attenuating qualities, *which components each cover a large range of potential footwear user body weights*, and a range of different sport activities or casual walking." *Id.* at col. 2 ll. 20-25 ("for footwear" not explicitly in original) (emphasis added). Santiyanont further claims that "[a]n insole/midsole component [for footwear] made from an elastomer according to the invention is particularly useful for dress shoes and sport shoes of all types, and *in particular is suitable for different body weight ranges of potential users.*" *Id.* at col. 2 ll. 26-30 ("in footwear" not explicitly in original; note repeated singular use of component and elastomer).

Santiyanont subsequently discusses the invention in a manner consistent with a 'same material' interpretation. Santiyanont identifies an "insole portion 16," an "insole or midsole portion 36," and an "insole/midsole portion 36" and differentiates such structure from the insole pads themselves. *Id.* at col. 2 l. 58 to col. 3 l. 5 and Figs. 1B and 2. Santiyanont at no time describes the pads as an insole/midsole component so as to support the Office's argument. At its

AMENDMENT AFTER NON-FINAL ACTION

Appln. No. 10/686,353

Docket No. 066491-00007

greatest level of detail, Santianont describes an illustrated embodiment in which "insole pads 22 and 24 are made of elastomer according to the invention *such as Specimen A* referred to in Table 2..." *Id.* at col. 2 ll. 63-65 and Fig. 1B (note singular use of elastomer and use of same material) (emphasis added). Santianont more generally states that "it will be appreciated that the polyisoprene elastomer pads can be provided in footwear having a plurality of insole and/or midsole portions, and indeed in footwear having no midsole portion." *Id.* at col. 3 ll. 36-39. Santianont further states that "in place of two pads as shown in FIGS. 1 to 3, *a single pad of elastomeric material* extending from the forefoot to the heel may be provided." *Id.* at col. 3 ll. 39-42 (emphasis added). This description of embodiments having pads constructed from a single material, of footwear having a plurality of insole or midsole portions (that are not insole pads), and of an embodiment consisting of a single continuous pad all weigh in favor of a disclosure/teaching of footwear with a range of insole/midsole options, and against a disclosure/teaching of a single insole having different insole pad materials with different intrinsic properties.

Santianont concludes with claims to a sole component for footwear and an article of footwear which are consistent with a 'same material' interpretation. Both claims recite only a single elastomer material having a single set of properties, and are not further developed to claim a second elastomer having a different set of properties, or different properties within that same set of properties. The absence of such claims would be a significant oversight.

We respectfully argue that the above-referenced disclosure, when read by a person of ordinary skill in the art at the time the invention was made, and therefore without reference to the Applicants' specification, would not view Santianont at disclosing or suggesting an insole for footwear (or a sole for footwear) including multiple elastomeric pads having differing hardness and rebound properties that are combined within the same device. At the very least, the weight of the intrinsic evidence against such a claim provided in this response has served to rebut the two sentences offered by the Office as factual support for its *prima facie* case for obviousness.

AMENDMENT AFTER NON-FINAL ACTION

Appln. No. 10/686,353

Docket No. 066491-00007

*Santiyanont '056 does not disclose an insole combining multiple and different elastomeric pads where the first pad rebound is greater than the second pad rebound*

With regard to claims 11, 17-18, 37, and 40-41, the Office implicitly argues that Santiyanont '056 discloses an insole satisfying the recited claim limitations including the requirement that the first pad rebound be greater than the second pad rebound. The Office has not established a prima facie case for the obviousness of these claims because it provides no factual basis for the rejection. *See In re Zurko*, 258 F.3d at 1385 (Fed. Cir. 2001). Neither the cited portions of Santiyanont nor the combination of the Hardt '203 publication and Santiyanont '056 reference disclose, teach, or suggest that it would be desirable to provide an insole component including combining multiple and different elastomeric pads where the first pad rebound is greater than the second pad rebound. *See Application* at p. 2 ll. 12-17 and p. 5 ll. 6-14.

*Conclusion*

In view of the foregoing remarks, the Applicants respectfully submit that the claims are allowable over the art of record and pray for a prompt allowance. The Commissioner is authorized to charge any additional fees required or to credit any overpayment to Deposit Account No. 20-0809.

Respectfully submitted,

/David R. Jaglowski/

David R. Jaglowski

Reg. No. 58,514

THOMPSON HINE LLP

P.O. Box 8801

Dayton, Ohio 45401-8801

Telephone: (937) 443-6600

Facsimile: (937) 443-6635

E-mail: [IPGroup@ThompsonHine.com](mailto:IPGroup@ThompsonHine.com)

483473.1